

Application No.: 10/040,141
Attorney Docket No.: TOK00-006
Response Dated: April 11, 2005
Reply for Supplemental Office Action Dated: December 9, 2004

REMARKS

Claims 1-61 are pending in the application.

Claims 1, 21, 41, 50-52, and 61 have been amended to more particularly describe the invention. No new matter is added with the claim amendments. The claim amendments find full support in the disclosure at Pages 1-3, for example.

The Examiner has objected to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. As indicated in the Action, the objection is based on the following claim recitations: "means for displaying" (Claim 1); "means for saving data" (Claim 1); "means for transferring" (Claim 1); and "means for selecting" (Claim 21).

For the reasons below, Applicant respectfully submits that the specification provides clear and full support and antecedent basis for the claim recitations referenced by the Examiner.

The referenced claim recitations find clear support in the original disclosure at Pages 5-11 and in the drawings, for example.

In one illustrative form of the invention, the manner and means of displaying fuel dispenser options retrieved from a database, selecting the options, saving the selected options as a customized fuel dispenser design, and transferring the design to a location for constructing the dispenser finds clear support in the disclosure at, for example, Page 4, lines 7-8 (Fig. 3); Page 5, line 7 to Page 6, line 3; Page 7, line 7 to Page 8, line 6; and Page 8, line 14 to Page 10, line 8 (e.g., Page 5, lines 7-17 and Page 9, lines 8-20).

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In view of the foregoing, Applicant respectfully submits that the specification fully supports the claim recitations referenced by the Examiner as the basis for the objection, and requests that this objection be withdrawn.

Claims 1-40 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As indicated by the Examiner, the rejection is based on a purported lack of support in the specification for the following claim recitations: "means for displaying" (Claim 1); "means for transferring" (Claim 1); and "means for selecting" (Claim 21).

In view of the foregoing discussion concerning the objection to the specification, Applicant respectfully submits that these claim recitations referenced by the Examiner find full and clear support in the specification and hence are compliant with 35 U.S.C. §112, second paragraph. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claims 1-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,714,937 to Eynon et al. ("Eynon") in view of U.S. Patent No. 5,602,745 to Atchley et al. ("Atchley").

The Examiner states that it would be obvious to modify Eynon (online ordering of a customized computer product) in view of Atchley (fuel dispenser system) so as to adapt Eynon to arrive at the invention (computer-aided creation of a customized fuel dispenser design), since, according to the Examiner, Atchley "discloses customizing a fuel pump in the design phrase

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[sic]" and "such a modification would have allowed the supplier to more easily respond to the desired types of fuel pumps required by various fuels in different locations."

For the reasons below, Applicant respectfully submits that a *prima facie* case of obviousness has not been established. The Examiner has provided no suggestion or motivation drawn from either cited reference to make and sustain the proposed modification, nor has the Examiner presented a convincing line of reasoning - in the absence of an express or implied suggestion to combine from the cited art - to establish that the skilled artisan would have found it obvious to make the proposed modification. (MPEP §2142). Accordingly, it would not be obvious as the Examiner suggests to make the proposed modification.

Eynon is directed solely to an online process for ordering a customized computer system product, such as a personal computer machine configured to user preference. Atchley discloses a fuel dispenser structure that employs a controller including a plurality of microcontroller (microprocessor) nodes connected over a common communications bus to provide a multi-processing distributed computing environment offering decentralized control, which Atchley describes as an apparent improvement over prior dispensers using a single processor for centralized control. (Col. 3, lines 1-10 and Col. 6, lines 54-58). Atchley does disclose that the field installation unit may be provided in different configurations, which the Examiner characterizes as "customizing" a dispenser design. (Col. 7, lines 53-66; Col. 8, lines 51-67; Col. 15, lines 24-55; and Col. 17, lines 1-25).

Referring to the rejection, it is seen that the Examiner's statement that "Atchley discloses customizing a fuel pump in the design phrase [sic]" is understood merely to refer to the Atchley

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disclosure that the fuel dispenser may be provided in different configurations, which falls well short of supporting the modification to Eynon and does not teach or suggest the invention, i.e., the computer-aided design of a customized fuel dispenser that employs, for example, the computer-aided creation of a customized fuel dispenser design by providing a database with fuel dispenser options, displaying the fuel dispenser options retrieved from the database, selecting the options in a customized manner, saving the selected options as a customized fuel dispenser design, and transferring the design to a location for constructing the dispenser according to the customized design. This disclosure in Atchley - that the dispenser can be provided in different selective configurations (i.e., customized) - is an insufficient grounds for modifying Eynon in the manner proposed by the Examiner and cannot be relied upon as a basis for asserting that it would be obvious to adapt the Eynon system (online ordering of a computer product) to the computer-aided creation of a customized fuel dispenser design, as in the invention.

The mere disclosure in Atchley that a fuel dispenser can be customized (i.e., provided in different configurations according to various options) cannot serve as a basis to adapt Eynon to the computer-aided creation of a customized fuel dispenser design, as in the invention. The Atchley "customization" does not at all amount to any teaching or suggestion - in reference to Eynon - that would render it obvious for one skilled in the art to adapt the ordering process of Eynon (customized personal computer order) to the computer-aided creation of a design order for constructing a customized fuel dispenser, as in the invention. For example, there is simply no teaching or suggestion in Atchley regarding any machine-assisted process to create a dispenser design or the use of computer-aided tools (i.e., computer-aided design system of the invention)

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to create a customized fuel dispenser design. The purported customized "design" disclosure in Atchley that the Examiner cites (i.e., that dispensers can have different configurations) does not teach or suggest the specific design implementation of the invention, i.e., the computer-aided creation of a customized fuel dispenser design by providing a database with fuel dispenser options, displaying the fuel dispenser options retrieved from the database, selecting the options in a customized manner, saving the selected options as a customized fuel dispenser design, and transferring the design to a location for constructing the dispenser according to the customized design.

As a further foundational basis for establishing the determination of obviousness, and specifically to articulate the requisite motivation to combine the references in the proposed manner, the Examiner states that "such a modification would have allowed the supplier to more easily respond to the desired types of fuel pumps required by various fuels in different locations." However, this foundation is not found in either Eynon or Atchley, nor does the Examiner rely upon any specific identified disclosure or make any citation to the references to support this apparent motivation to combine. This asserted motivation is likewise deficient as not presenting a sufficient line of reasoning to support the rejection, specifically the proposed modification of Eynon in view of Atchley.

According to the Examiner's motivation to combine, a supplier would recognize that the fueling requirements of different dispenser locations might require different types of fuel pumps to accommodate the various fueling demands. However, merely because a supplier might recognize the need for different dispenser architectures (e.g., the different configurations

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indicated by Atchley) does not at all amount to any teaching or suggestion directed to the use of a computer-aided design process to construct a customized fuel dispenser design, much less serve as a motivation (sufficient for obviousness) to adapt an online ordering process for a customized computer product (Eynon) to the implementation of a computer-aided design system to create a customized fuel dispenser design, as in the invention. The mere fact that such a supplier may need to "respond" to the need for different dispenser configurations does not make it obvious to one skilled in the art (having resort to Eynon) to adapt the Eynon system - which is limited to online ordering of a customized personal computer - to the computer-aided creation of a customized fuel dispenser design.

Applicant respectfully submits that the combination proposed by the Examiner can only be rendered on the basis of impermissible hindsight taken from Applicant's disclosure.

In view of the foregoing, Applicant respectfully submits that Claims 1-61 are patentable over Eynon in view of Atchley, and requests that this rejection be withdrawn.

Regarding the numbered paragraphs 10-13 and 18 found at Pages 4-9 and 10-11 of the Office Action, Applicant furnishes the following remarks.

The Examiner makes several requests for Applicant to reply to certain matters and indicates that the lack of a reply will operate as an admission or concession.

The Examiner has set forth no statutory or administrative authority under the applicable sections of Title 35 of the United States Code or Title 37 of the Code of Federal Regulations as a basis for requiring a reply to the noted paragraphs. The Examiner offers 37 C.F.R. §1.111(b) as a foundation for the requirements, but this is insufficient.

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The following authorities are cited in relevant part (emphasis added):

37 C.F.R. §1.111(b): In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner ... must reply to every ground of objection and rejection in the prior Office action. ... If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.

35 U.S.C. §1.132(a): Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; ...

37 CFR 1.104 Nature of examination. (a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

In view of the foregoing, Applicant respectfully submits that the noted paragraphs in the Office Action do not set forth any rejection, objection, or requirement as to form necessitating a reply by Applicant. Additionally, contrary to the Examiner's statements, Applicant's failure to respond to the noted paragraphs shall not operate as any acquiescence, concession, or admission, either explicitly, implicitly, inferentially, or otherwise, to the positions taken by the Examiner set

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forth in paragraphs 10 *et seq.* No adverse inference or implication shall be drawn from the lack of any reply to sections of the Office Action not directly bearing upon a rejection or objection or requirement as to form. The lack of any specific reply to such paragraphs of the Action shall not be deemed an admission or acquiescence by Applicant as to any matters asserted by the Examiner. Applicant considers that this Response is complete and fully responsive to the Office Action, in accord with the applicable sections of Title 35 of the United States Code, Title 37 of the Code of Federal Regulations, and the MPEP.

Applicant respectfully submits that the application is in condition for allowance and requests favorable action in accordance therewith.

If the Examiner has any questions or comments that would advance prosecution of this case, the Examiner is invited to call the undersigned at 260/484-4526.

Respectfully Submitted,


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RJK/jrw2

Enclosures: Amendments to the Claims

(7 Sheets)

Explanatory Cover Sheet - Page 1
Petition for Extension of Time
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on: April 11, 2005.


Randall J. Knuth, Registration No. 34,644
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Date